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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,617	01/08/2002	Ingo F. Herrmann	089317-000000US	4164

20350 7590 10/21/2003

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,617

Applicant(s)

HERRMANN, INGO F.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-34, 36-41, 43-47, 49 and 50 is/are rejected.
- 7) ☒ Claim(s) 35, 42, 48, 51 and 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27, 28, 31-33, 49 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose a device with a holding device which includes both a magnetic holding structure (now in claim 25) and a loop (claims 27 and 28), both a magnetic holding structure and a catch element/hook (claims 31, 32, 49 and 50), or both a magnetic holding structure and a fastening hoop. (claim 33).

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 25, 26, 29-32, 34, 36-41 and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Adair (U.S. Pat. 5,643,175) for the reasons set forth in the previous Office Action, paper number 7 with respect to claims 1, 2, 5-9, 14, 16-20 and 22-24. Note the Examiner's

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remarks below in the Response to Arguments section with respect to the features that Applicant contends are lacking in Adair.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adair.

Adair discloses a maximum cross-sectional dimension (7 mm, col.6, lines 3-6) of the capsule portion (C, Fig.3) but fails to particularly point out the cross-sectional dimension of the tool channel (28, Fig.3), which ultimately dictates the size of the additional instrument (forceps 30). If not inherent from the relative sizes of the tool channel (28) and overall diameter of the capsule portion (C) in Figure 3 (note that any channel that was slightly under one half the cross-sectional dimension of the overall diameter of the capsule portion would be no more than about 3 mm in diameter--and channel 28 is illustrated as being much smaller than that), it would have been obvious to one of ordinary skill in the art to have made the tool channel, and thus the additional instrument as small in diameter as possible so as to keep the overall dimensions of the device small. Since a diameter of 2 mm is not extraordinary in the art of surgical tools, including forceps, this would have been an obvious size within a range of sizes for one of ordinary skill.

Response to Arguments

6. Applicant's arguments filed August 11, 2003 have been fully considered but they are not persuasive.

With respect to the Adair reference, Applicant evidences that the capsule section and the channel section of Adair are fixed with respect to each other in the longitudinal direction. The Examiner concurs. However, Applicant seems to be equating the channel section (S_b) with the additional instrument recited in the claim. In contrast, the forceps (30 or 122) correspond to the claimed additional instrument. Claim 25 calls for the fiberscope part and the at least one additional instrument to be displaceable relative to one another in the longitudinal direction of the unit. Although the channel section and the capsule section (fiberscope part) may not be, the forceps (122) and capsule section are. Note that the previous rejection with respect to Adair equates the additional instrument to the forceps (122).

Furthermore, Applicant argues the unit has a non-round cross-section. Again, note that the previous rejection with respect to Adair specifically points out (col.2, line 43) that the unit can have a non-round cross-section.

Allowable Subject Matter

7. Claims 35, 42, 48, 51 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamamoto et al. (U.S. Pat. 6,059,719)—note magnetic coupling of instrument to endoscope.

Ishikwawa et al. (U.S. Pat. 6,071,233)—note coupling of instrument to endoscope.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

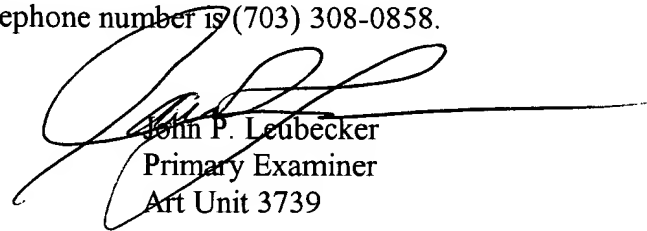
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl